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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,964	12/21/2001	Keith Dirks	2206.66001	7478

7590

09/12/2003

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EXAMINER

DEMILLE, DANTON D

ART UNIT PAPER NUMBER

3764

DATE MAILED: 09/12/2003

*JP*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/037,964

Applicant(s)

DIRKS ET AL.

Examiner

Danton DeMille

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Information Disclosure Statement***

1. The information disclosure statement filed 31 July 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-19, drawn to a hand held massager, classified in class 601, subclass 15.

II. Claims 20-21, drawn to a combined actuator and pump assembly, classified in class 222, subclass 102. The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention actuator and pump assembly has separate utility such as for dispensing lotion without the massager. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Lawrence Crain on 01 July 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-19.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-4, 6, 11, 12, 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rurup.** As broadly recited, Rurup teaches a housing having a gripping portion 8, a body contacting portion 1, a vibrator 3, a fluid outlet 6 and a heated applicator pad 2 for emitting heat with the fluid outlet disposed in close proximity to the pad. Regarding claim 11, Rurup teaches a pocket 9 and at least one massaging enhancement pad 2. The at least one massaging enhancement pad 2 enhances the massaging action by adding heat to the body contacting portion. The enhancement pad has a smooth surface.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 5, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rurup in view of Kiefer et al.** Rurup appears silent with regard to exactly how one is to control the temperature and vibration of the device however, any conventional means used to vary the temperature and degree of vibration such as a rheostat would have been an obvious provision in Rurup. One would need to control the temperature of the heat and amount of vibration dependent on practical considerations of intended use. Kiefer teaches such a convention. It would have been obvious to one of ordinary skill in the art to modify Rurup to include means to control the amount of heat and vibration such as taught by Kiefer to control the operation of the device. Regarding claims 7-9, it is well known to be able to adjust the amount of vibration and any specific range of vibrations would have been obvious. The specific amount of vibration is dependent on the intended use and the desired type of massage. Any conventional amount would have been an obvious provision in Rurup.

11. **Claims 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rurup in view of Kiefer et al. and further in view of Cheng '159.** Cheng teaches rubber bolts 5 for isolating the gripping portion from the body contacting portion. It would have been obvious to one of ordinary skill in the art to further modify Rurup to use vibration isolating members as taught by Cheng to damping the vibration of the vibrator from the gripping portion.

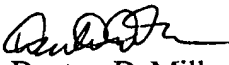
**12. Claims 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**McGrath in view of Kiefer et al.** McGrath teaches a hand held massager comprising a housing having a gripping portion 94, configured for emitting a massaging liquid 82 and a body contacting portion 42. While McGrath may not teach the body contacting portion emits heat, Kiefer teaches the convention of adding heat to the body contacting portion. It would have been obvious to one of ordinary skill in the art to modify McGrath to configure the body contacting portion to emit heat as taught by Kiefer to provide the added benefit of heat therapy. The reservoir 58 is pivotally mounted by hook-shaped projection 64 dimensioned to extend through an opening 66 in main housing 12.

**13. Claims 1, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Sivan et al. in view of Kiefer et al.** Kiefer teaches a housing, a pump using motor 46 and removable reservoir 10 pivots to the refill position shown in figure 1 and pivotable cover 8. Sivan may not teach the body contacting portion being configured for emitting heat, Kiefer teaches such a convention. It would have been obvious to one of ordinary skill in the art to modify Sivan to emit heat on the body contacting portion as taught by Kiefer to provide the added benefit of heat therapy.

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